

### **DOUBLE PATENTING**

A. Claims 1-37 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-30 of U.S. Patent No. 6,080,392.<sup>1</sup>

Applicant respectfully requests that this rejection be held in abeyance until allowable subject matter has been found.

B. Claims 1-37 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims of copending Application No. 09/265,850, Application No. 09/402,801, and Application No. 09/402,797.

Applicants respectfully requests that this rejection be held in abeyance until allowable subject matter has been found.

### **REJECTION UNDER 35 U.S.C. §112**

Claims 22-29 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for (i) reciting "derived from", and (ii) for reciting improper Markush groups. Applicant respectfully traverses both rejections.

Claims 22, 26, 28, and 29 have been amended to change "derived from" to -- obtained from--. The new phrase is supported in the originally filed specification and claims and would be readily understood by one of ordinary skill in the art.

The phrase "chosen from" has been rejected as being in improper Markush format, as allegedly shown by M.P.E.P. § 2173.05(h). However, Applicant points out that "selected from the group consisting of" is not the only acceptable alternative language format. M.P.E.P. § 2173.05(h) states the proper test: "Alternative

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<sup>1</sup> The Examiner has rejected claims 1-37. Applicant notes that claims 1-15 are not pending in this application and has responded to this rejection for pending claims 16-37.

expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims." The guidance for examination continues: "One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being 'selected from the group consisting of A, B and C.' " M.P.E.P. § 2173.05(h)(I), *citing Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925) (emphasis added). Other examples of acceptable alternative claim language published by the PTO may be found in the following sources: M.P.E.P. Appendix AI (PCT), Example 20, p. AI-44 of the July 1998 edition ("wherein R1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S)."); *Training Materials For Examining Patent Applications with Respect to 35 U.S.C. Section 112, First Paragraph - Enablement Chemical/Biotechnical Applications*, released August, 1996 ("X selected from A, B, and C"). In sum, the PTO expects and allows alternative claim language other than the strict formulation "selected from the group consisting of," and provides a test for determining proper alternative claim language.

Applying the proper test to Applicant's claim language, no uncertainty or ambiguity is found. For example, in claim 23, Applicant claims that the "carboxylic acids are chosen from acrylic acids, methacrylic acids, crotonic acids, maleic acids, fumaric acids, and itaconic acids." Applicant finds "no uncertainty or ambiguity with respect to the question of scope or clarity" of this claim language. Applicant asserts that the Examiner has not shown improper alternative claim language, and therefore has not shown how the claims are indefinite.

Reconsideration and withdrawal of the rejection are respectfully requested.

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**REJECTION UNDER 35 U.S.C. §102(e)**

Claims 16-19, 21-23, 25-29, 35, and 37 have been rejected under 35 U.S.C. §102(e) over Dupuis et al. (U.S. Patent No. 6,080,392). Applicant respectfully traverses the rejection.

In order to anticipate a claim, a reference must contain all elements of the claim. See *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Further, a single source must disclose all of the claimed elements "arranged as in the claim." See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The law requires identity between the claimed invention and the prior art disclosure. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983).

The Examiner states that Dupuis teaches "a formula (I), where  $R_1$  and  $R_2$  may be identical or different and are  $C_8$ - $C_{18}$  hydrocarbon radicals." (Office Action at 5.) At most, Dupuis teaches that  $R_1$  and  $R_2$  may both be  $C_8$  hydrocarbon radicals or that one of  $R_1$  and  $R_2$  may be a  $C_8$  hydrocarbon radical while the other is a  $C_9$ - $C_{18}$  hydrocarbon radical. However, Dupuis does not teach at least one nonionic amphiphilic associative polyurethane corresponding to formula (I) in which one of the radicals  $R_1$  and  $R_2$  is an alkyl group having 8 to 18 carbons and the other group is an alkyl having 1 to 6 carbons, as presently claimed.

For at least this reason, Dupuis does not anticipate the claimed invention.

Reconsideration and withdrawal of the rejection are respectfully requested.

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**REJECTION UNDER 35 U.S.C. §103(a)**

Claims 20, 24, 30-34, and 36 have been rejected under 35 U.S.C. §103(a) over Dupuis in view of Cauwet (U.S. Patent No. 5,478,562) and Prencipe (U.S. Patent No. 5,385,729) in further view of Carey.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. § 2143 (7<sup>th</sup> ed. 1998). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Additionally, the evidence of a teaching, suggestion, or motivation to combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). As the Federal Circuit has stated, the Office must demonstrate a teaching or motivation to combine the prior art references to overcome the "powerful attraction of a hindsight-based obviousness analysis." *Id.*

The Examiner argued that "[a]n alkyl group comprising 6 carbons is homologous to one comprising 8 carbons." (Office Action at 1.) The Examiner relied on *In re Henze*, 181 F.2d 196, 85 U.S.P.Q. 261 (C.C.P.A. 1950) for the proposition that "a presumption of unpatentability arises against a claim directed to a composition of matter, the **adjacent** homologue of which is old in the art." (Emphasis added.)

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Homology, however, should not automatically lead to a conclusion of *prima facie* obviousness. See *In re Elpern*, 326 F.2d 762, 767, 140 U.S.P.Q. 224, 228 (C.C.P.A. 1964) (stating that the greater the difference in the carbon chain, the better the chance to argue against the presumption of obviousness).

Moreover, in *In re Mills*, 281 F.2d 218, 221 (C.C.P.A. 1960), the court stated that "[w]here, as here, the invention for which a patent is sought relates to one member of an homologous series and the disclosure of the prior art is of a non-adjacent member of the series, *In re Heinze*, is not authority for a 'legal presumption' of obviousness of the claimed invention." In *In re Mills* the examiner used this "legal presumption," rather than facts, to bridge the gap between a C(1) and C(8) to C(12) alkyl sulphates. The court stated that "the 'presumption of unpatentability' referred to in the Henze case, was limited to a claim directed to a composition of matter (a new compound), the adjacent homologue of which was old in the art." *Id.* at 223. The court noted that there was no evidence in the record from which it could be determined that "the mere existence of a homologous relationship between compounds as widely separated as 1 and 8 to 12 will support a 'reasonable' 'presumption of unpatentability.'" *Id.* The court stated that "[I]f the Patent Office wishes to rest a rejection on chemical theory, it is its duty to support its case with adequate evidence of the existence and meaning of that theory." *Id.*

Applicants would first like to point out that an alkyl group comprising 1 to 6 carbons is not an **adjacent** homolog to an alkyl group comprising 8 carbons. Moreover, the presently claimed invention, is directed to one substituent being an alkyl group having from 1 to 6 carbons and another substituent being an alkyl group having from 8 to 18 carbons. This is in stark contrast to the primary reference which only teaches that

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either of its substituents should be alkyl group having from 8 to 18 carbons. There is no suggestion in the primary reference that one of the substituents have an entirely different range of carbons present in its alkyl group. Specifically, there is no suggestion in the primary reference for the two substituents to have two alkyl groups with two different ranges of carbon atoms.

Finally, Applicant would like to point out that the Examiner has pointed to no evidence to support her "presumption of unpatentability" that a compound have an alkyl group ranging from 8 to 18 carbons renders obvious a compound having two substituents, one of which is an alkyl group having from 1 to 6 carbons, the other of which is an alkyl group having from 8 to 18 carbons. Absent such evidence, the Examiner has failed to establish a *prima facie* case of obviousness based on a homologous relationship.

Cauwet et al. does not overcome the deficiencies of Dupuis et al. In particular, Cauwet et al. teach a cosmetic composition comprising at least one nonionic surface-active agent of the alkyl polyglycoside and/or polyglycerolated type and at least one polyetherurethane. See col. 1, lines 63-67. However, Cauwet et al. does not teach or suggest a cosmetic composition comprising at least one nonionic amphiphilic associative polyurethane corresponding to a formula wherein the R and R' are different and defined such that one is an alkyl group having 8 to 18 carbons and the other group is an alkyl group having 1 to 6 carbons.

Prencipe et al. does not overcome the deficiencies of Dupuis et al. and Cauwet et al. The Examiner relies on Prencipe et al. for teaching a personal care composition containing a cross-linked polymer derived from a polymer containing repeating units in

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which one or more phosphonic acid groups are bonded to one or more carbon atoms in the polymer chain. See Office Action, page 8, and Prencipe et al., col. 5, lines 65-68. However, Prencipe et al. does not teach or suggest a cosmetic composition comprising at least one nonionic amphiphilic associative polyurethane corresponding to a formula wherein the R and R' are different and defined such that one is an alkyl group having 8 to 18 carbons and the other group is an alkyl group having 1 to 6 carbons.

Carey does not overcome the deficiencies of Dupuis et al, Cauwet et al., and Prencipe et al. The Examiner relies on Carey for the teaching that "condensation reactions are inherently known to give a product accompanied by the expulsion of a stable molecule when two molecules are combined." See Office Action, page 9, last sentence. However, Carey does not teach or suggest a cosmetic composition comprising at least one nonionic amphiphilic associative polyurethane corresponding to a formula wherein the R and R' are different and defined such that one is an alkyl group having 8 to 18 carbons and the other group is an alkyl group having 1 to 6 carbons.

The combination of references does not teach or suggest all of the claim elements, and thus the first criteria for a *prima facie* case of obviousness has not been met. Moreover, there is no "clear and particular" suggestion or motivation in the references to modify Dupuis et al. so that one of the C<sub>8</sub>-C<sub>18</sub> hydrocarbon radicals is changed to a C<sub>1</sub>-C<sub>6</sub> alkyl group. Absent Applicant's disclosure, there is no reasonable expectation of success that such a modification would result in a polyurethane that is compatible with (B) at least one anionic polymer comprising at least one fatty-chain monomer unit in a cosmetic composition. Reconsideration and withdrawal of the rejection are respectfully requested.

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**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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